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|--|-------------|----------------------|---------------------|------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/777,808 | 02/12/2004 | Marc W. Todd | 50037.211US01 | 5841 |
| 27488 7590 07/01/2009 MERCHANT & GOULD (MICROSOFT) P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903 | | | | |
| EXAMINER | | | | |
| BETTT, JACOB F | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2169 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 07/01/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/777,808

Applicant(s)

TODD ET AL.

Examiner

JACOB F. BETIT

Art Unit

2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27 April 2009 has been entered.

Remarks

2. In response to communications filed on 27 April 2009, claims 1, 11, and 18 have been amended per the applicant's request. Claims 1-23 are presently pending in the application.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 10, 11-16, 18-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sprint Online User's Guide PCS Phone Handspring Treo 300 User Guide, known hereinafter as Treo in view of Grossman et al. (U.S. patent No. 2004/0119732 A1); Microsoft Middlecast - Windows XP; and Nicolas et al. (U.S. patent No. 7,551,899 B1).

As to claim 1, Treo teaches a method for displaying recent items, comprising:

determining a recent item from recently accessed items on a device; wherein the recently accessed items on the device include: recent incoming phone calls; recent outgoing phone calls; and recent access of contacts (see page 94, Reviewing Call History);

replacing the recent item with a contact maintained in a contact list when the item has an associated contact (see page 94, screen shot and see page 95 Adding a Call History Entry to Contacts);

placing the recent item in a recent items list that includes all recently accessed items (see page 94, screen shot);

generating the recent items list such that recent items associated with a contact are coalesced and shown as only one item within the recent items list; wherein the recent items list includes both recent items that were replaced by a contact and recent items that were not replaced by a contact (see page 94, screen shot, where each incoming outgoing or missed call is only displayed once); and

displaying the recent items list (see page 94, screen shot); and

displaying a context menu when the recent item is selected; wherein the context menu includes:

in response to determining the recent item was not replaced by a contact, an option to create a new contact for the recent item (see page 95, “Adding a Call History entry to your Contacts list”, “3. Under Record, select Add (/N)”);

an option to an option to remove the recent item from the recent items list (see page 107, Call History view).

Treo does not distinctly disclose including an option to beam the recent item in the Call History “record” view.

However, Treo does include beaming a contact in other “record” menus (see page 107, Contacts list view; Contacts edit view; and Contacts record view. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Call History “record” in Treo to include creating a new contact and beaming a contact because it would allow added functionality of allowing new address book entries to be added to the address book from the Call History and of allowing contact information from calls from the Call History to be sent to other users using menu items already available in other embodiments of Treo.

Treo as modified, does not distinctly disclose wherein the recently accessed items include recently received electronic messages or recent outgoing electronic messages.

However, Grossman et al. teaches including email and phone numbers see paragraph 0043 and 0046. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Treo as modified, to include the teachings of Grossman et al. because these teachings would allow the user to contact a recent correspondence with email or telephone.

Treo as modified, does not distinctly disclose the recent items list generated such that recent items related to pinned contact are listed higher than items from a standard contact more recently received, and in response to determining the recent item was replaced by a contact, an option to pin a selected contact displayed in the recent items list.

However, Microsoft Middlecast - Windows XP teaches pinning programs to a start menu of recently and frequently accessed programs. (see Pin Programs to the Start Menu). While Microsoft Middlecast-Windows XP does not show treating items like “contacts” that replace phone numbers differently and determining if an item has been replaced by a contact, Treo as modified, does change menus based on if the item is a phone number or a phone number that is replaced by a contact (see page 96 “2. Press Menu” and “3. Under Record, select Add (/N)” and see page 107, “Call History view” where the “Add” choice has been removed for a known contact). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Treo as modified, to include the teachings of Microsoft Middlecast - Windows XP because this would allow the user to have more control over what items are displayed on a list of frequently accessed contacts. Further, it would be a design choice to select which menus the pinning option is available on and putting this option on only some of the menus would be well within the ability to one having ordinary skill in the art at the time of the invention.

Treo as modified, still does not distinctly disclose generating the recent items list such that recent items associated with a contact are coalesced and shown as only one item.

Nicolas et al. teaches this, see column 5, line 52 through column 6, line 5; see column 6, lines 26-50; and see 30-55, “most used numbers” lists contacts with one number based on the amount of times that number has called or been called, when doing the number search over all the tables, line 46 of column 7 teaches removing all duplicates. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Treo as modified to include the teachings of Nicolas et al. because this would remove

redundant data so that it is easier for users to make a selection that is desired. Further, Nicolas et al. was meant to be performed on a device similar to a Trio.

As to claim 2, Treo as modified, teaches wherein determining the recent item further comprises determining a time associated with a communication associated with the recent item (see Treo, page 94, Details and page 107, Call History view).

As to claim 3, Treo as modified, does not distinctly disclose wherein determining the recent item further comprises determining a frequency associated with communications associated with the recent item.

However, Grossman et al. teaches this, see paragraph 0011 and 0046 “frequency of selecting particular contacts”. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Treo as modified, to include the teachings of Grossman et al. because these teachings would allow the users to see a list of contacts accessed most of a period of time instead of seeing contacts accessed most recently.

As to claim 4, Treo as modified, does not distinctly disclose further comprising determining a frequency associated with the communication.

However, Grossman et al. teaches this, see paragraph 0011 and 0046 “frequency of selecting particular contacts”. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Treo as modified, to include

the teachings of Grossman et al., because these teachings would allow the users to see a list of contacts accessed most of a period of time instead of seeing contacts accessed most recently.

As to claim 5, Treo as modified, teaches further comprising replying to the recent item by using any available communication method (see Treo, page 95, Calling a number in your Call History list, where calling the number is the available communication method).

As to claim 6, Treo as modified, teaches wherein the communication method is selected from a set comprising a telephone call, an IM message, an SMS message, MMS message and an email (see Treo, page 95, Calling a number in your Call History list, where calling the number is the available communication method).

As to claim 7, Treo as modified, teaches wherein the recent item list is limited to a predetermined number of recent items (see Treo, page 94, "quick access to the previous 1,000 incoming and outgoing calls").

As to claim 8, Treo as modified, teaches wherein determining the recent item further comprises determining when a communication associated with the recent item is private and when the communication is private marking the communication as a non-recent item and not including the recent item in the recent items list (see Treo, page 72, Making records private).

As to claim 10, Treo as modified, teaches further comprising turning off the display of the recent items list based on a setting (see Treo, page 196, Auto-off delay).

As to claim 11, Treo teaches a system for displaying recent items, comprising:
a communications connection configured to receive a communication (see page 95, “Make sure wireless mode is on. See page 10 for details”);

a display configured to display a recent items list (see page 94, screen shot); and
a recent items application configured to perform actions, including:
determining a recent item from recently accessed items; wherein the recently accessed items include: recent incoming phone calls; recent outgoing phone calls; and recent access of contacts (see page 94, Reviewing Call History);

replacing the recent item with a contact maintained in a contact list when recent item has an associated contact within a contact list (see page 94, screen shot, page 95 Adding a Call History Entry to contacts);

placing the recent item in the recent items list that includes all recently accessed items (see page 94, screen shot);

generating the recent items list (see page 94, screen shot); and
displaying the recent items list on the display (see page 94, screen shot);
displaying a context menu, wherein an option in the context menu depends on whether a selected recent item is replaced by a contact (see page 96 “2. Press Menu” and “3. Under Record, select Add (/N)” and see page 107, “Call History view” where the “Add” choice has been removed for a known contact).

Treo does not distinctly disclose including recently received electronic messages and recent outgoing electronic messages.

However, Grossman et al. teaches including email and phone numbers see paragraph 0043 and 0046. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Treo to include the teachings of Grossman et al. because these teachings would allow the user to contact a recent correspondence with email or telephone.

Treo does not distinctly disclose recent items associated with a contact are coalesced and shown as only one item.

Nicolas et al. teaches this, see column 5, line 52 through column 6, line 5; see column 6, lines 26-50; and see 30-55, “most used numbers” lists contacts with one number based on the amount of times that number has called or been called, when doing the number search over all the tables, line 46 of column 7 teaches removing all duplicates. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Treo as modified to include the teachings of Nicolas et al. because this would remove redundant data so that it is easier for users to make a selection that is desired. Further, Nicolas et al. was meant to be performed on a device similar to a Trio.

Treo as modified, does not distinctly disclose recent items related to a pinned contact are listed higher than items from a standard contact.

However, Microsoft Middlecast - Windows XP teaches pinning programs to a start menu of recently and frequently accessed programs. (see Pin Programs to the Start Menu). While Microsoft Middlecast-Windows XP does not show treating items like “contacts” that replace

phone numbers differently and determining if an item has been replaced by a contact, Treo as modified, does change menus based on if the item is a phone number or a phone number that is replaced by a contact (see page 96 “2. Press Menu” and “3. Under Record, select Add (/N)” and see page 107, “Call History view” where the “Add” choice has been removed for a known contact). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Treo as modified, to include the teachings of Microsoft Middlecast - Windows XP because this would allow the user to have more control over what items are displayed on a list of frequently accessed contacts.

As to claim 12, the applicant is directed to the citations of claim 2 above.

As to claim 13, the applicant is directed to the citations of claim 3 above.

As to claim 14, the applicant is directed to the citations of claim 5 above.

As to claim 15, the applicant is directed to the rejection of claim 7 above.

As to claim 16, the applicant is directed to the citations of claim 8 above.

As to claim 18, Treo teaches a computer-readable storage medium for displaying recent items, comprising:

determining a recent item from recently accessed items; wherein the recently accessed items include: recent incoming phone calls; recent outgoing phone calls; and recent access of contacts (see page 94, Reviewing Call History);

attempting to associate the recent item with a contact maintained in a contact list (see page 94, screen shot and see page 95, Adding a Call History Entry to contacts);

placing the recent item in a recent items list that includes all recently accessed items (see page 94, screen shot);

generating the recent items list (see page 94, screen shot); and

displaying the recent items list (see page 94, screen shot).

Treo does not distinctly disclose including recently received electronic messages and recent outgoing electronic messages.

However, Grossman et al. teaches including email and phone numbers see paragraph 0043 and 0046. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Treo to include the teachings of Grossman et al. because these teachings would allow the user to contact a recent correspondence with email or telephone.

Treo does not distinctly disclose recent items associated with a contact are coalesced and shown as only one item.

Nicolas et al. teaches this, see column 5, line 52 through column 6, line 5; see column 6, lines 26-50; and see 30-55, “most used numbers” lists contacts with one number based on the amount of times that number has called or been called, when doing the number search over all the tables, line 46 of column 7 teaches removing all duplicates. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Treo as modified to include the teachings of Nicolas et al. because this would remove redundant data so that it is easier for users to make a selection that is desired. Further, Nicolas et al. was meant to be performed on a device similar to a Trio.

Treo as modified, does not distinctly disclose recent items related to a pinned contact are listed higher than items from a standard contact.

However, Microsoft Middlecast - Windows XP teaches pinning programs to a start menu of recently and frequently accessed programs. (see Pin Programs to the Start Menu). While Microsoft Middlecast-Windows XP does not show treating items like “contacts” that replace phone numbers differently and determining if an item has been replaced by a contact, Treo as modified, does change menus based on if the item is a phone number or a phone number that is replaced by a contact (see page 96 “2. Press Menu” and “3. Under Record, select Add (/N)” and see page 107, “Call History view” where the “Add” choice has been removed for a known contact). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Treo as modified, to include the teachings of Microsoft Middlecast - Windows XP because this would allow the user to have more control over what items are displayed on a list of frequently accessed contacts.

As to claim 19, the applicant is directed to the citations of claim 2 above.

As to claim 20, the applicant is directed to the citations of claim 5 above.

As to claim 21, the applicant is directed to the citations of claim 8 above.

As to claim 23 the applicant is directed to the citations of claim 10 above.

5. Claims 9, 17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sprint Online User’s Guide PCS Phone Handspring Treo 300 User Guide, known hereinafter as

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Treo in view of Grossman et al.; Microsoft Middlecast - Windows XP; and Nicolas et al. as applied to claims 1-8, 10, 11-16, 18-21, and 23 above and in further view of SoloMio.

As to claim 9, Treo as modified, does not distinctly disclose further comprising displaying the time of the communication within a title bar of a contacts window when the recent item is highlighted.

However, SoloMio teaches this see below.

solomiO

SoloMio Missed Call List



SoloMio Services

SoloMio Copyright 2003

Figure 1- a list of recent items

solomiO

SoloMio Missed Call Option Menu



SoloMio Services

SoloMio Copyright 2003.

Figure 2- displaying the time of the last communication in the title bar.

Therefore, it would have been obvious to have modified Treo as modified above to include the teachings of SoloMio because this would convey information that may be necessary to a user to the user in a very efficient manner.

As to claim 17, the applicant is directed to the citations of claim 9 above.

As to claim 22, the applicant is directed to the citations of claim 9 above

Response to Arguments

6. Applicant's arguments filed 27 April 2009 have been fully considered but they are not persuasive.

In response to the applicant's arguments that "[the] cited references do not teach generating a recent items list such that recent items associated with a contact are coalesced and shown as only one item", the arguments have been considered, but are moot in view of the new grounds of rejection given above.

In response to the applicant's arguments that "the cited references do not teach a determination of whether a recent item was replaced by a contact", the arguments have been considered, but are not deemed persuasive. It can be evidenced that the menus change based on the Treo manual. According to page 96, when you go to the Record Menu after selecting a number you want to add (that is not already in the address book). The Record Menu gives you an option to Add that contact. However, in the call history view of the Record Menu on page 97 no add option is displayed because the number is already associated with a contact.

In response to the applicant's arguments that "the cited references do not teach recent items received from a pinned contact are being listed higher than items from a standard contact", the arguments have been considered, but are not deemed persuasive. In the "Microsoft Middlecast - Windows XP" document, it is shown that any item that is pinned goes directly to the top of list. Therefore all pinned items will necessarily be above or higher than all non-pinned or standard items regardless of call history.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and can be found on the attached form PTO-892.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACOB F. BETIT whose telephone number is (571) 272-4075. The examiner can normally be reached on Monday through Friday 9:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on (571) 272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Jacob F B  tit/
Examiner, Art Unit 2169

jfb
24 Jun 2009